In the Supreme Court of the United States

OCTOBER TERM, 1955

No. 734

ROBERT JULES TATINCLOUX and ROGER GEORGES GUY, *Petitioners*

v.

THE COMMISSIONER OF PATENTS

On Petition for a Writ of Certiorari to the United States Court of Customs and Patent Appeals

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BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The final opinion of the United States Court of Customs and Patent Appeals (Pet. App. 27-34) is reported at 228 F. 2d 238.

JURISDICTION

The decision of the Court of Customs and Patent Appeals was originally rendered on April 28, 1955 (Pet. App. 17-24). Rehearing was granted on July 1, 1955 (Pet. App. 26) and a new opinion was substituted for the prior decision on December 8, 1955 (Pet. App. 27-34). The final order is dated January 16, 1956 (Pet. App. 35). The petition for a writ of certiorari was filed on March 6,

1956. Petitioners attempt to invoke the jurisdiction of this Court under 28 U. S. C. 1256 (Pet. 2).

QUESTION PRESENTED

Whether this Court has jurisdiction to review a decision by the United States Court of Customs and Patent Appeals, which affirmed the refusal of the Board of Appeals of the United States Patent Office to grant a patent on two of the claims set out in petitioners' application.

STATEMENT

Petitioners seek a review of the denial of two of the claims contained in their application for a patent on "Refractories and Methods of Making Them" filed by them with the Commissioner of Patents (R. 1). The portions of their application which were denied consist of process Claims Numbers 19 and 29 which cover an alleged invention of a new process for producing refractories[1] from refractory substances generally and from clay specifically (R. 39-40). The claimed improvement over the prior art results from the introduction of the solidifying agent simultaneously with the formation of gas bubbles, instead of first forming the gas bubbles and then adding the solidifying agent as disclosed by a prior patent (R. 40, 41, Pet. 30). Petitioners claim, *inter alia,* that their process produces refractories having substantially greater

[1] The refractories referred to are bricks used for the construction of high temperature furnaces (Pet. 10).

crushing strength, and also greater regularity and uniformity, and that new forms can be produced by the use of their method (R. 24, 36-37, Pet. 12).

The Primary Examiner in the United States Patent Office allowed two of the claims contained in petitioners' application and rejected the remaining claims, including Claims 19 and 29 here involved (R. 31, Pet. 17). The Board of Appeals of the Patent Office sustained the decision of the Primary Examiner rejecting Claims 19 and 29 on the ground that the matter disclosed was unpatentable over a prior patent (R. 40, Pet. 17). On appeal, the United States Court of Customs and Patent Appeals affirmed with respect to the two claims, holding that the said claims "do not define invention" over the previously issued patent (Pet. App. 27-34).[2] The court noted that "[a]s a general rule, no invention is involved in the broad concept of performing simultaneously operations which have previously been performed in sequence," but recognized that "[a]n exception may be made where a new and unexpected result is obtained by performing the operations simultaneously." However, the court concluded that "it

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[2] The Board of Appeals reversed the Primary Examiner as to seven of the rejected claims, but sustained the rejection of the others, including Claims 19 and 29. The Court of Customs and Patent Appeals reversed the Board as to two of the claims rejected by the Board, but affirmed the rejection of Claims 19 and 29.

has not been satisfactorily shown in the present case that such a result is obtained" (Pet. App. 33).

ARGUMENT

This petition, like that filed by the same counsel in *Ducci* v. *Commissioner of Patents* (Oct. Term, 1955, No. 603), certiorari denied, March 5, 1956, seeks review of the denial of an application for a patent filed by the petitioners with the Commissioner of Patents. The question presented is whether the particular claims, which were unanimously rejected by the Patent Office, the Board of Appeals of the Patent Office, and the Court of Customs and Patent Appeals, disclosed a patentable invention, as distinguished from a process or product improvement indicated by the prior art or obvious to any one skilled in the art. That issue is essentially a question of fact, and in this case it has been unanimously resolved adversely to petitioners by the appropriate administrative agency and the court below, which have the peculiar expertise requisite to its resolution. Hence, further review is not called for.

Moreover, as set out in detail in the respondent's brief in opposition in the *Ducci* case, *supra* (at pp. 4-7), the decisions of this Court show that this Court lacks jurisdiction to review the decision of the Court of Customs and Patent Appeals in the instant matter. We respectfully refer the Court to the grounds for denial of the petition thus set out in the respondent's brief in opposition in the

Ducci case, which are hereby incorporated by reference.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied for want of jurisdiction.

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